

Appl. No. 09/965,224
Amndt. Dated 06/10/2004
Reply to Office action of 04/07/2004

REMARKS/ARGUMENTS

Claims 1-57 are pending in the present application.

This Amendment is in response to the Final Office Action mailed April 7, 2004. In the Final Office Action, the Examiner rejected claims 10-13, 15, 19, 29-32, 34, 38, 48-51, 53, 57 under 35 U.S.C. §102(e); and claims 1-9, 14, 16-18, 20-28, 33, 35-37, 39-47, 52, 54-56 under 35 U.S.C. §103(a). Reconsideration in light of the remarks made herein respectfully requested.

In the Final Office Action, the Examiner states that "[i]n response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., it does not analyze the content to extract a description) are not recited in the rejected claims." (Final Office Action, page 23) Applicant respectfully disagrees.

Contrary to the Examiner's contention, these features are recited in the rejected claims. Independent Claims 10, 29, and 48 were amended in the previous response, against the 102 rejections, to recite in part:

"a content analyzer to analyze a content.. to extract a description ..; and a content filter ... to filter the content using the extracted description..."

(Amended claims 10 and 48). (emphasis added.)

"analyzing a content.. to extract a description ..; and filtering the content using the extracted description..." (Amended claim 29). (emphasis added.)

Independent claims 1, 20, and 39 were not amended in the previous response but arguments were presented to traverse the 103 rejections.

The Examiner further states that "[a]lthough the claims are interpreted in light of the specification, limitations from the specifications are not read into the claims", citing In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant respectfully disagrees.

First, the features recited by the Applicant in the previous response are to provide the Examiner an opportunity to review the specification. Those are intended to help interpreting the claim language. They are not limitations read into the claims.

Second, the Examiner apparently misread Van Geuns. In Van Geuns, the claim in question recites a magnet assembly with a uniform magnetic field. The applicant in Van Geuns argues that the uniform magnetic field limitation must be interpreted in light of the specification

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which discloses the magnetic field uniformity for NMR or MRI imaging. In rejecting this argument, the Court states that the "short answer is that [the] claim ... is not expressly limited to NMR or MRI apparatus". In re Van Guens, 26 USPQ2d at 1059. The court further states that the applicant cannot read an NMR limitation into the claim to justify his argument as to the meaning of the uniform magnetic field. The Van Guens rule, therefore, is only applicable if the claim does not expressly recite the limitation. Here, the limitation of "analyzing the content to extract a description" is recited in the claim. It is not limitation read into the claims.

Other court decisions state that claims should be interpreted according to the specification. Claims should be interpreted consistently with the specification, which provides content for the proper construction of the claims because it explains the nature of the patentee's invention. Renishaw, 158 F.3d 1243, 48 USPQ2d 1117 (Fed. Cir. 1998). The Renishaw court explicitly states that when "a patent applicant has elected to be a lexicographer by providing an explicit definition in the specification for a claim term, .. the definition selected by the applicant controls." Renishaw, 48 USPQ2d 117, 1121. During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification". See MPEP 2111. "When the applicant states the meaning that the claim terms are intended to have, the claims are examined with that meaning, in order to achieve a complete exploration of the applicant's invention and its relation to the prior art". In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 13320, 1322 (Fed. Cir. 1989). In In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969) the Court explained that "reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from "reading limitations of the specification into a claim," to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim". See also In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ 2d 1023, 1027-28 (Fed. Cir. 1997) (The Court held that the PTO is not required, in the course of prosecution, to interpret claims in applications in the same manner as a court would in interpreting claims in an infringement suit. Rather, the "PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification.").

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The limitation of "analyzing the content to extract a description" distinguishes the claimed invention from the cited prior art references. This limitation should be interpreted according to the specification as discussed above.

Therefore, Applicant believes that independent claims 1, 10, 20, 29, 39, 48 and their respective dependent claims are distinguishable over the cited prior art references. Accordingly, Applicant respectfully requests the rejections under 35 U.S.C. §102(e), and 35 U.S.C. §103(a) be withdrawn.

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Conclusion

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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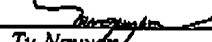
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